

REMARKS

Initially, Applicants would like to thank the Examiner for acknowledging acceptance of the drawings filed with the present application on December 16, 2003. Applicants would also like to thank the Examiner for acknowledging receipt of Applicants' claim for foreign priority under 35 U.S.C. §119, as well as receipt of a certified copy of the priority document upon which Applicants' claim for foreign priority is based. Applicants would further like to thank the Examiner for acknowledging consideration of each of the documents listed on a Form PTO-1449 submitted with the Information Disclosure Statement filed on March 15, 2004.

In the outstanding Official Action, claims 1-16 were rejected under 35 U.S.C. §103(a) over GENNAMI (U.S. Patent No. 6,672,101) in view of JANG (U.S. Patent No. 6,237,362).

Upon entry of the present amendment, claims 1-16 will have been cancelled without prejudice to or disclaimer of the subject matter recited therein. Claims 17-34 will have been added for consideration. In this regard, claims 17-33 recite combinations of subject matter similar to the combinations previously recited in claims 1-16. However, claims 17-33 have been revised to eliminate informalities and to more clearly recite the features of the invention to which the claims are directed. Additionally, claim 33 recites a feature similar to a feature of claim 1 which is not recited in independent claim 17.

In view of the cancellation of claims 1-16, the rejection of claims 1-16 has been rendered moot. Nevertheless, Applicants traverse the rejection of claims 1-16 insofar as new claims 17-33 recite features similar to the combinations previously recited in claims 1-16.

With respect to the outstanding rejection, the proposal to modify GENNAMI with the teachings of JANG based on a motivation to "remarkably improve the oil separating efficiency of

the oil separator" in GENNAMI would apply only as a motivation to provide a "U-shaped profile bulged at opposite side surfaces thereof". In other words, there would not appear to be a proper motivation to modify GENNAMI with the remaining features of the refrigerant go-around passage and the liquid returning port which the Official Action acknowledges are absent from GENNAMI.

That is, the Official Action asserts that it would be obvious to modify GENNAMI "by specifically modifying the oil separation device, as taught by JANG, in order to remarkably improve the oil separating efficiency of the oil separator (see col. 13, lines 12-19)". However, the above-noted benefit cited in JANG is disclosed to be a result of a "specifically designed U-shaped profile bulged at opposite side surfaces thereof as best seen in FIGS. 3 and 4", so that "primarily recovered oil, attached on the surface of the chamber 21 during the spattering of the gas refrigerant on the cover 2, is free from being trailed by the dynamic force of the oil-laden gas refrigerant flowing along the U-shaped passage within the chamber 21". Accordingly, even using the motivation cited in the Official Action for modifying GENNAMI with the teachings of JANG, one would be motivated only to provide an "oil-separating chamber 21" with a "specifically designed U-shaped profile". However, this is not itself a motivation to provide such a U-shaped oil-separating chamber 21 to GENNAMI, nor a motivation to provide GENNAMI, as modified with such a U-shaped oil-separating chamber 21, with the remaining characteristic features of the refrigerant go-around passage and liquid returning port recited in claim 17 (i.e., the remaining features which are acknowledged to be absent in the teachings of GENNAMI).

Therefore, the motivation cited in the Official Action is not a motivation to modify GENNAMI with the numerous features of claim 17 that are acknowledged to be absent from

GENNAMI. Accordingly, there is no proper motivation to modify GENNAMI to include a *"refrigerant go-around passage for introducing the refrigerant discharged from the compression mechanism into the housing via a refrigerant introducing port, making the refrigerant go around an axial line of the compressor and returning the refrigerant to a discharge-port side of the housing via a refrigerant returning port, while separating the liquid from the refrigerant by centrifugation or by centrifugation and collision, wherein a liquid returning port is provided for returning the separated liquid into the housing in a wall of a mid part of the refrigerant go-around passage in such a manner that the liquid returning port has an orientation that has a component in a direction of gravity and that is deviated from a traveling direction of the refrigerant"* as recited in claim 17. Rather, the only motivation to modify GENNAMI to include the above-noted combination of features is the improper motivation to obtain Applicants' claim 17 in hindsight. Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of independent claim 1, as well as an indication of the allowability of independent claim 17 which recites a combination similar to the combination previously recited in independent claim 1.

Additionally, contrary to the assertions in the Official Action, JANG fails to disclose the features of at least claims 21-22, 24, 28-29 or 31 in the manner asserted in the Official Action. That is, contrary to the assertions in the Official Action, JANG fails to disclose that "the refrigerant go-around passage is constituted by a concave streak and a lid for covering the concave streak, the concave streak being formed on a substrate attached to the housing or to an end wall of the housing" as recited in claim 21. JANG also fails to disclose that "the substrate is attached to the housing together with the lid" as recited in claim 22. JANG further fails to

disclose that "a guide for collecting the refrigerant to direct the collected refrigerant into the refrigerant introducing port is provided in the refrigerant introducing port" as recited in claim 24. JANG further fails to disclose "the refrigerant go-around passage being constituted by a concave streak and a lid for covering the concave streak, the concave streak being formed on a substrate attached to the housing or to an end wall of the housing" as recited in claim 28. JANG additionally fails to disclose that "the substrate is attached to the housing together with the lid" as recited in claim 29. Moreover, JANG fails to disclose that "a guide for collecting the refrigerant to direct the collected refrigerant into the refrigerant introducing port is provided in the refrigerant introducing port" as recited in claim 31. Accordingly, even modification of GENNAMI with the teachings of JANG would fail to result in the above-noted features recited in claims 21-22, 24, 28-29 and 31. Therefore, each of claims 21-22, 24, 28-29 and 31 is separately allowable for reasons in addition to the allowability of claim 17.

Applicants have also added claim 34 to recite that a cross-sectional area of the refrigerant go-around passage is substantially uniform. The features of claim 34 are supported in the drawings of the present application. In contrast to the features recited in claim 34, JANG discloses that an oil-separating chamber (passage) 21 has a "U-shaped profile bulged at opposite side surfaces thereof". Accordingly, the cross-sectional area of the passage 21 in JANG is not substantially uniform as is recited in new claim 34.

By way of explanation, the cross-sectional area of the middle part of the passage in JANG is larger than that of the part adjacent to the refrigerant inlet port 13. This configuration in JANG reduces the speed of refrigerant, thereby allowing oil contained in the refrigerant to fall by gravitation. In contrast, the refrigerant go-around passage according to claim 34 has a

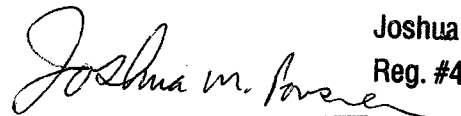
substantially uniform cross-sectional area which maximizes the benefit of the centrifugal force of the refrigerant. This benefit of the features recited in claim 34 can be further enhanced by providing a collision wall 36 to narrow the refrigerant go-around passage and thereby increase the speed of the refrigerant. In any case, the features recited in claim 34 are specifically not disclosed by JANG, and there is no proper motivation to modify JANG to include such features. Therefore, claim 34 is separately allowable for reasons in addition to the reasons for the allowability of claim 17.

At least for each and all of the reasons set forth above, Applicants respectfully request entry of claims 17-34 as well as an indication of the allowability of each of the claims now pending.

Any amendments to the claims which have been made in this Response, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should there be any questions regarding this paper, any representative of the U.S. Patent and Trademark Office is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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